

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT :	McErlean <i>et al.</i>	CONFIRMATION No. :	1503
SERIAL NUMBER :	09/640,103	EXAMINER :	Alina A. Boutah
FILING DATE :	August 15, 2000	ART UNIT :	2443
PATENT No. :	7,603,415	ISSUE DATE :	October 13, 2009
FOR :	CLASSIFICATION OF ELECTRONIC MESSAGES USING A HIERARCHY OF RULE SETS		

Mail Stop: Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705(d)

Applicants request reconsideration of patent term adjustment for the above-referenced application. Also enclosed is the two-hundred dollar fee as required by 37 C.F.R. § 1.18(e).

The above-identified application issued on October 13, 2009. The total patent term adjustment calculated by the United States Patent and Trademark Office under 35 U.S.C. §154(b) is 841 days, which is recited on the face of the above-referenced patent. Applicants petition the U.S. Patent and Trademark Office for reconsideration of the patent term adjustment calculation to **1347 days** based on the facts provided herein. This Request is submitted in view of the decision by the U.S. District Court decision in *Wyeth v. Dudas* (D.D.C. 2008) on September 30, 2008 and Applicants' duty under 37 C.F.R. 1.765.

This patent application was filed on August 15, 2000, and is therefore subject to the patent term adjustment procedures set forth in 37 C.F.R. §§ 1.702 to 1.705 for applications filed on or after May 29, 2000.

On October 5, 2000, the Office mailed a Notice to File Missing Parts of Non-Provisional Application.

On October 30, 2000, Applicant filed a response to the Notice to File Missing Parts. This response was received by the Office within three-months of the mailing date of the Notice.

On July 30, 2004, the Office mailed a Non-Final Office Action. The action was mailed 1019 days after the fourteen month requirement for mailing of the first action after the date on which the application was filed under 35 U.S.C. §111(a). As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 1019 day Office delay.

On December 30, 2004, Applicant filed a Response to Non-Final Office Action with a two-month extension of time. This Response was filed 61 days after the date that is three months after the mailing date of the Office Action. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 61 day Applicant delay.

On January 13, 2005, Applicants submitted a supplemental Information Disclosure Statement, which qualified as a submission under 37 C.F.R. 1.704(c)(8). As this paper was not expressly requested by the Examiner and was filed after a Response had been filed, the period of adjustment begins on the day after the date the initial reply was filed, *i.e.* January 1, 2005, and ends on the date that the other paper was filed, *i.e.* January 13, 2005, which is 14 days. This delay is not accounted for by the U.S. Patent Office. In accordance with 37 C.F.R. 1.765, Applicants' duty of candor and good faith toward the Office, Applicants believe an additional **14 days** of Applicant delay should be applied.

On April 8, 2005, the Office mailed a Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On July 8, 2005, Applicants filed a Response to Final Office Action. This Response was received within three months of the mailing date of the Action.

On August 11, 2005, the Office mailed a Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On January 10, 2006, Applicants filed a Request for Continued Examination with a two month extension of time. Applicants note that the USPTO recorded the filing date of the Request as January 2, 2006. In accordance with 37 C.F.R. 1.765, Applicants' duty of candor and good faith toward the Office, Applicants believe the delay associated with this filing is **60 days** not the 52 shown in Exhibit A.

On April 19, 2006, the Office mailed a Non-Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On August 10, 2006, Applicants filed a Response to Non-Final Office Action with a one month extension of time. This Response was filed 22 days after the date that is three months

after the mailing date of the Office Action. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 22 day Applicant delay.

On November 1, 2006, the Office mailed a Non-Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On March 29, 2007, Applicants filed a Response to Non-Final Office Action with a two month extension of time. This Response was filed 56 days after the date that is three months after the mailing date of the Office Action. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 56 day Applicant delay.

On June 5, 2007, the Office mailed a Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On September 4, 2007, Applicants filed a Notice of Appeal. This Notice was received within three months of the mailing date of the Office Action.

On March 4, 2008, Applicants filed an Appeal Brief.

On May 28, 2008, the Office mailed a Non-Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §134.

On August 27, 2008, Applicants filed a Response to Non-Final Office Action. This Response was received within three months of the mailing date of the Office Action.

On November 14, 2008, the Office mailed a Non-Final Office Action. This Action was mailed within the four months of the filing of the reply filed under 35 U.S.C. §132.

On January 26, 2009, Applicants filed an Appeal Brief. This Appeal Brief was received within three months of the mailing date of the Office Action.

On June 8, 2009, the Office mailed the Notice of Allowance/ Notice of Allowability, and the Determination of Patent Term Adjustment for this application. The Notice was mailed 13 days after the four month requirement for the USPTO to respond to a reply filed under 35 U.S.C. §132. As shown in Exhibit A, the number of days of Patent Term Adjustment accounts for the 13 day Office delay.

On September 3, 2009, Applicants paid the Issue Fee. This payment was received within three months of the mailing date of the Notice.

On October 13, 2009 the patent issued. The patent issued within four months of the paying the issue fee under 35 U.S.C. §151.

According to the provisions of 37 C.F.R. §1.702(b), Applicants are entitled to Patent Term Adjustment for the failure of the Office to issue the patent within three years after the date on which the application was filed. Under 37 C.F.R. §1.702(b)(1)-(5), Applicants are entitled to this adjustment for any time other than time consumed by continued examination of the application requested by the applicant under section 132(b), beginning on the date on which a Request for Continued Examination was filed, January 10, 2006, and ending on the date the patent issued, October 13, 2009.

The amount of the Adjustment under 37 C.F.R. §1.702(b) is calculated from August 16, 2003 (*i.e.*, the day after the date that is three years from the date that the application was filed), through the day before the date the Request for Continued Examination was filed, *i.e.* January 9, 2006, subtracting only time legitimately attributable to Applicant delay. However, Applicants note that from August 16, 2003 through July 30, 2004, which is 350 days, delay under 37 C.F.R. 1.702(a) and 37 C.F.R. 1.702(b) overlaps. Applicants submit that the Adjustment under 37 C.F.R. §1.702(b) is $878-350=528$ days.

Applicants have calculated the Patent Term Adjustment based on 37 C.F.R. 1.702(a), 37 C.F.R. 1.702(b) and 37 C.F.R. 1.704 through October 13, 2009, the Issue Date of the patent. The total calculation of Patent Term Adjustment is as follows: Office delay under 37 CFR 1.702(a) is $1019+13=1032$ days; Office Delay under 37 CFR 1.702(b) is 528 days; and Applicant delay under 37 CFR 1.704(c) is: $61+14+60+22+56=213$ days, adjustment is **$1032+528-213=1347$ days.**

Applicants respectfully request that the Patent Term Adjustment be increased from 841 days, as reported on the Determination of Patent Term Adjustment under 35 U.S.C. 154 (b), to **1347 days.**

If the Office would like to discuss any aspect of this filing, the Office representative assigned to process this request is welcome to call the undersigned attorney. Applicants believe no additional fees are due. However, the Office is authorized to charge such fee, or credit any overpayment in fees to Deposit Account No. **50-0311**, Customer Number **30623**, Attorney Docket No. 26321-502001US.

Respectfully submitted,

/Erica R. Carlson /

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Date: December 10, 2009

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Exhibit A

09/640,103	CLASSIFICATION OF ELECTRONIC MESSAGES USING A HIERARCHY OF 12-09-RULE SETS	2009::12:49:37
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Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 09/640,103

Filing or 371(c) Date:	08-15-2000	USPTO Delay (PTO) Delay (days):	1032
Issue Date of Patent:	10-13-2009	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	191
Post-Issue Petitions (days):	+0	Total PTA (days):	841
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
09-23-2009	PTA 36 Months		
10-13-2009	Patent Issue Date Used in PTA Calculation		
09-11-2009	Dispatch to FDC		
09-11-2009	Application Is Considered Ready for Issue		
09-03-2009	Issue Fee Payment Verified		
09-03-2009	Issue Fee Payment Received		
06-08-2009	Mail Notice of Allowance	13	
06-06-2009	Notice of Allowance Data Verification Completed	⬆	
06-06-2009	Document Verification	⬆	
03-26-2009	Appeal Brief Review Complete	⬆	
03-26-2009	Date Forwarded to Examiner	⬆	
01-26-2009	Appeal Brief Filed	⬆	
01-26-2009	Notice of Appeal Filed		
12-15-2008	Miscellaneous Incoming Letter		
11-14-2008	Mail Non-Final Rejection		
11-12-2008	Non-Final Rejection		
10-06-2008	Case Docketed to Examiner in GAU		
09-17-2008	Date Forwarded to Examiner		
08-27-2008	Response after Non-Final Action		
05-28-2008	Mail Non-Final Rejection		
05-27-2008	Non-Final Rejection		
03-28-2008	Request for Refund		
03-13-2008	Appeal Brief Review Complete		
03-13-2008	Date Forwarded to Examiner		
03-04-2008	Appeal Brief Filed		
03-04-2008	Request for Extension of Time - Granted		
09-04-2007	Notice of Appeal Filed		
12-30-2004	New or Additional Drawing Filed		
10-30-2000	Oath or Declaration Filed (Including Supplemental)		
06-05-2007	Mail Final Rejection (PTOL - 326)		
05-29-2007	Final Rejection		

04-06-2007	Date Forwarded to Examiner	
03-29-2007	Response after Non-Final Action	56
03-29-2007	Request for Extension of Time - Granted	⬆
11-01-2006	Mail Non-Final Rejection	⬆
07-20-2004	Non-Final Rejection	
08-15-2006	Date Forwarded to Examiner	
08-10-2006	Response after Non-Final Action	22
08-10-2006	Request for Extension of Time - Granted	⬆
07-25-2006	Mail Examiner Interview Summary (PTOL - 413)	⬆
07-20-2006	Examiner Interview Summary Record (PTOL - 413)	⬆
04-19-2006	Mail Non-Final Rejection	⬆
04-17-2006	Non-Final Rejection	
11-14-2005	Information Disclosure Statement considered	
02-04-2006	Date Forwarded to Examiner	
01-02-2006	Request for Continued Examination (RCE)	52
02-04-2006	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)	⬆
01-10-2006	Workflow - Request for RCE - Begin	⬆
11-14-2005	Reference capture on IDS	⬆
11-14-2005	Information Disclosure Statement (IDS) Filed	⬆
11-14-2005	Information Disclosure Statement (IDS) Filed	⬆
11-16-2005	Mail Advisory Action (PTOL - 303)	⬆
11-14-2005	Advisory Action (PTOL-303)	⬆
11-09-2005	Date Forwarded to Examiner	⬆
10-11-2005	Amendment after Final Rejection	⬆
08-11-2005	Mail Final Rejection (PTOL - 326)	⬆
08-08-2005	Final Rejection	
07-28-2005	Date Forwarded to Examiner	
07-08-2005	Amendment after Final Rejection	
01-13-2005	Electronic Information Disclosure Statement	
01-13-2005	Information Disclosure Statement (IDS) Filed	
09-29-2004	Electronic Information Disclosure Statement	
09-29-2004	Information Disclosure Statement (IDS) Filed	
11-24-2000	Request for Refund	
04-08-2005	Mail Final Rejection (PTOL - 326)	
04-04-2005	Final Rejection	
01-26-2005	Date Forwarded to Examiner	
12-30-2004	Response after Non-Final Action	61
12-30-2004	Request for Extension of Time - Granted	⬆
12-30-2004	Incoming Letter Pertaining to the Drawings	⬆
08-12-2004	Electronic Information Disclosure Statement	⬆
08-12-2004	Information Disclosure Statement (IDS) Filed	⬆

07-30-2004	Mail Non-Final Rejection	1019
07-22-2004	Non-Final Rejection	⬆
06-22-2004	IFW TSS Processing by Tech Center Complete	⬆
05-26-2004	Case Docketed to Examiner in GAU	⬆
05-26-2004	Case Docketed to Examiner in GAU	⬆
03-30-2004	Case Docketed to Examiner in GAU	⬆
07-31-2003	Case Docketed to Examiner in GAU	⬆
07-31-2003	Case Docketed to Examiner in GAU	⬆
07-31-2001	Case Docketed to Examiner in GAU	⬆
11-14-2000	Application Dispatched from OIPE	⬆
11-14-2000	Application Is Now Complete	⬆
10-05-2000	Notice Mailed--Application Incomplete--Filing Date Assigned	⬆
10-05-2000	Correspondence Address Change	⬆
09-06-2000	IFW Scan & PACR Auto Security Review	⬆
08-15-2000	Initial Exam Team nn	⬆

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